



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: YAM=1

In re Application of:)	Art Unit: 1617
)	
Daniel YAM)	Examiner: S. WANG
)	
I.A. No.: PCT/IL99/00564)	Washington, D.C.
I.A. Date: October 25, 1999)	
)	
Appln. No.: 09/830,357)	
Date Filed: July 17, 2001)	Confirmation No. 1056
)	
For: PREPARATION AND USE OF)	May 20, 2002
SOLIDIFIED OILS)	

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REPLY TO RESTRICTION AND ELECTION REQUIREMENTS

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant is in receipt of Paper No. 10, an Office Action mailed April 23, 2002, entirely in the nature of a restriction requirement and several election of species requirements.

The present application is the National Stage of a PCT application, and applicant has claimed priority from his priority application filed in Israel on October 25, 1998. A copy of the priority application should have been forwarded to the PTO from the International Bureau. Applicant accordingly respectfully requests acknowledgement by the PTO of the receipt of applicant's papers filed under \$119.

Restriction has been required among what the Examiner deems to be four (4) patentably distinct inventions. As applicant must make an election, even though the requirement is traversed, applicant hereby respectfully and provisionally elects Group II, presently designated as containing claims 61-92 and 97, directed to a nutritional supplement and its method of manufacture, with traverse and without prejudice, particularly as between Groups II and III.

Thus, even under U.S. restriction practice, Groups II and III are closely tied together, the first being the nutritional supplement and the second being the food additive in which the supplement is contained. These two groups do not have different issues regarding patentability, do not have different issues regarding enablement, and do not require separate searches. Therefore, they should be examined together under the provisions of MPEP 806, second paragraph. Indeed, it is absolutely clear that Groups II and III are so closely tied together that one cannot be considered in its entirety without considering the other, and therefore it would not be a serious burden to examine these two groups together. Under these circumstances, restriction between Groups II and III is absolutely prohibited.

Moreover, the standards are even more strict under unity-of-invention rules, which of course apply in this case

as is recognized by the examiner (MPEP 823 and 1896). The criterion to be applied is the same or corresponding special technical feature or features. This certainly is present in all of applicant's claims in the composition of claim 61 which, as admitted by the PTO, is common to all of the four groups. The requirement is certainly inconsistent with unity-of-invention standards, which the PTO is obligated to follow under International treaty.

Applicant accordingly respectfully requests withdrawal of the restriction requirement and examination on the merits of all of applicant's claims.

As understood, there are also three separate election of species requirements, namely a first election from among the liquid oils, a second election from among the solid fats, and a third election from among the additional ingredients.

As to the first species, applicant respectfully and provisionally elects fish oil as the liquid oil, with traverse and without prejudice. The claims which read on the fish oil, of course in addition to the generic claims (e.g. claim 61), are claims 64, 65, 70-73, 84-88, 90-92, 95 and 97.

As regards solid fats, applicant hereby provisionally and respectfully elects beeswax, with traverse and without prejudice. In addition to the generic claims,

e.g. claim 61, beeswax is covered by claims 68, 70-73, 84-88, 90-92, 95 and 97.

As regards the additional ingredients, applicant respectfully and provisionally elects a flavoring agent, with traverse and without prejudice. In addition the generic claims, a flavoring agent is covered by claims 79-81, 87 and 88.

The examiner has helpfully provided listings at the top of page 4 of where the various claims fit, and the examiner's listing can be partially accepted by applicant with the following additional notes, and in addition to the designations presented above. Thus, claim 62 and 63 are at least partially generic to other oils in addition to fish oil. As regards the flavoring agent, claims 61-80 are generic as they do not exclude a flavoring agent, and indeed claims 82 et seq are also generic.

The species requirements are traversed because there is no provision under PCT rules for such an election of species requirement. The species are simply various options which fall within the generic invention as called for in claim 61. What is recited in claim 61 is, as already noted above, the same or corresponding special technical feature which exists in all of the claims, regardless of the details of the

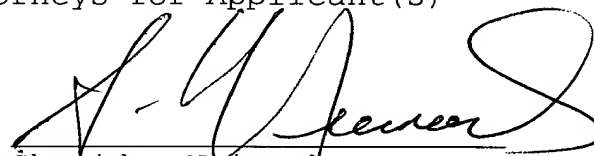
particular oils, solid fats, and additives which may be chosen.

Applicant requests withdrawal of the election of species requirements, and again requests examination of all of the claims on the merits.

Respectfully submitted,

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Daniel YAM

Application No.: 09/830,357

Filed: July 17, 2001

For: PREPARATION AND USE OF SOLIDIFIED OILS

Confirmation No.: 1056

Art Unit: 1617

Examiner: s. WANG

Washington, D.C.

Atty.'s Docket: yam=1

Date: May 20, 2002

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is a [XX] REPLY TO RESTRICTION AND ELECTION REQUIREMENTS in the above-identified application.

[XX] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

[] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

[XX] No additional fee is required.

The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

ADDITIONAL FEE TOTAL

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 42	\$
+ 135	\$
ADDITIONAL FEE TOTAL	

OR

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 84	\$
+ 270	\$
TOTAL	

OR

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
- ** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
- *** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [] First - \$ 55.00
- [] Second - \$ 200.00
- [] Third - \$ 460.00
- [] Fourth - \$ 720.00

Month After Time Period Set

[] Less fees (\$) already paid for month(s) extension of time on .

Other Than Small Entity

Response Filed Within

- [] First - \$ 110.00
- [] Second - \$ 400.00
- [] Third - \$ 920.00
- [] Fourth - \$ 1440.00

Month After Time Period Set

- [] Please charge my Deposit Account No. 02-4035 in the amount of \$.
- [] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.
- [] A check in the amount of \$ is attached (check no.).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

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